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**JUN 16 2004**

**OFFICE OF PETITIONS**

In re Application of  
Yee, et al  
Application No. 09/942,976  
Filed: 29 August, 2001  
Attorney Docket No.: 220772009200

ON PETITION

This is a decision on the petition filed on 28 January, 2004, to revive the instant application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.137(b) is  
**GRANTED.**

BACKGROUND

The record reflects that:

- it appeared that Petitioner failed to reply timely and properly to the Notice of Missing Parts mailed on 9 October, 2001, with a reply due absent a request and fee for extension of time on or before Monday, 10 December, 2001;
- a result, the application was deemed abandoned after midnight 9 December, 2001;
- no Notice of Abandonment was mailed;
- because petition, Petitioner alleged non-receipt of the Notice of Missing Parts, the matter first was considered as a request to withdraw the holding of abandonment, however, that request was dismissed on 10 June, 2004, because--(a) at the time the Notice

of Missing Parts was mailed, the mailing address was Townsend and Townsend and Crew, Two Embarcadero Center/Eighth Floor, San Francisco, CA 94111-3834, and the Notice of Change of Address to Morrison & Foerster LLP, 755 Page Mill Road, Palo Alto, CA 94304-1018, did not occur until 26 February, 2002--and so Petitioner had failed to timely Notice the Office of a Change of Address.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup> And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>

As of this writing, Petitioner has filed a petition (with fee authorization to Deposit Account 03-1952: \$665.00) to revive under 37 C.F.R. §1.137(b) and the reply (fees (basic filing: \$385.00, total claims: \$486.00, independent claims: \$473.00, and surcharge: \$65.00) and oath/declaration), and made the statement of unintentional delay.

### CONCLUSION

Petitioner has satisfied the regulatory requirements, and, therefore, the petition under 37 C.F.R. §1.137(b) hereby is **granted**.

This application is being forwarded to OIPE for further processing as required before being sent for examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.